

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	
Quatse	:	Confirmation No. 9731
Application No.: 10/616,486	:	Group Art Unit: 3688
Filed: July 8, 2003	:	Examiner: Daniel Lastra
For:		HIGH-PRECISION CUSTOMER-BASED TARGETING BY INDIVIDUAL USAGE STATISTICS

PETITION UNDER 37 C.F.R. §1.182

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant contests the propriety of a new ground of rejection included in the supplemental examiner's answer for the above-identified patent application.

Applicant filed an appeal brief on April 16, 2007. The Examiner issued an answer on August 10, 2007. Applicant filed a reply brief on October 10, 2007. On December 5, 2008, the Examiner issued a supplemental answer. This supplemental answer included a new ground of rejection of claims 7-27 under 35 U.S.C. §101. This rejection had not been raised in any office action or in the Examiner's first answer.

Section 1207.05 of the Manual of Patent Examination and Procedure (“MPEP”) and 37 C.F.R. §41.43(a)(2) prohibits an Examiner from including a new ground of rejection in a supplemental answer. Rather, any new ground of rejection responding to a reply brief must be by way of reopening prosecution. MPEP §1207.05(1).

Attorney Docket No.: 134779.01101

At the suggestion of the Board of Patent Appeals and Interferences, Applicant's representative, on January 12, 2009, spoke to Director Wynn Coggins, the Director who approved the inclusion of the new ground of rejection. Director Coggins informed Applicant's representative that the Examiner should have reopened prosecution in this matter and that she would instruct James Myhre, the Supervisory Patent Examiner, to do so.

Examiner Myhre contacted Applicant's representative on January 12, 2009, and stated that the issuance of the new ground of rejection was proper because it was issued in an answer under MPEP §1207.02, and not in a supplemental answer in response to a reply brief under MPEP §1207.05. Applicant's representative pointed out to Examiner Myhre that MPEP §1207.02 imposes a two month period from the filing of the appeal brief for the issuance of an Examiner's answer. In this matter, the "answer" was issued 18 months after the filing of the appeal brief. Examiner Myhre could not provide an explanation as to how the issuance of an Examiner's answer or a supplemental answer that issued 18 months after the filing date of an appeal brief and contained a new ground of rejection was allowable under the MPEP. The only explanation Examiner Myhre could provide was that this was the way the United States Patent and Trademark Office decided to respond to pending appeals having potential §101 issues in light of *In re Bilski*, 545 F.3d 943 (Fed.Cir. 2008).

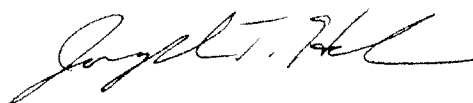
For the reasons stated above, Applicant asserts that the issuance of a new ground of rejection was improper and therefore petitions for the withdrawal of the new ground of rejection.

Attorney Docket No.: 134779.01101

Credit card payment of the \$400.00 petition fee under 37 C.F.R. §1.17(f) is enclosed. The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0436.

Respectfully submitted

PEPPER HAMILTON LLP

A handwritten signature in black ink, appearing to read "Joseph T. Helmsen", written in a cursive style.

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Date: January 15, 2009